

Remarks/Arguments:

Claims 1 - 49 and 51 - 56 stand finally rejected as obvious over prior art.

In particular, claims 1 - 17, 19 - 21, 23 - 31, 34, 40, 41, 43 - 46 and 51 - 53 are rejected as obvious over Dang in view of Fischell et al.

Claim 1 reads as follows:

1. An expandable endolumenal prosthesis comprising, in the non-expanded configuration,
 - a tubular body extending along a longitudinal axis and having a distal end and a proximal end;
 - the tubular body having a porous wall defined by a plurality of interlaced circumferential lines forming a pathway motif or pattern wherein at least one line is closed onto itself;
 - each of the lines extends along an axis;
 - each of the lines comprises at least one plurality of modules;
 - each module comprises three lobes, that is, two outer lobes and one inner lobe disposed between the two outer lobes in the pathway of the pattern;
 - each lobe comprising one or more curved sections having concavities facing in the same direction, defining an apex of the lobe;
 - the lobes opening alternately on opposite sides of the pathway of the pattern along the extent of the line;
 - both of the outer lobes of the three lobes being extended by straight outer arms;
 - the at least one plurality of modules being arranged consecutively so as to have successive outer arms which extend from the outer lobes in substantially opposite directions relative to the pathway of the pattern for two successive modules; and
 - wherein,

for each module, the distance between the apex of one of the outer lobes and the apex of the inner lobe of the same module is less than the distance between the apex of the same outer lobe and the apex of any outer lobe of an adjoining module;

for each line, there is at least one adjacent line which has a motif that is a mirror image of the said line with respect to an axis parallel to the axis of the line;

at least one connecting element or bridge is provided between two adjacent lines; and

each said bridge directly connects two opposed outer lobes of two adjacent lines, and each said bridge extends along a longitudinal axis parallel to the longitudinal axis of the tubular body;

one bridge is provided per module, said bridge extending towards an adjacent line on the opposite side to the outer arms of the module; and

each said bridge is provided between two adjacent lines, for every five complete lobes of a line, three outer lobes and two inner lobes.

The examiner, in rejecting claim 1, carefully explained at length what Dang discloses, and also identified what Dang does not disclose. He then found a teaching in Fischell which he deemed to render the missing structure obvious. With respect, we think his conclusion may have resulted from the use of hindsight, i.e., combining features from different prior art documents in order to arrive to a result that one could reach only by reading the disclosure of the present application. Picking and choosing elements from different documents to support a conclusion on obviousness is sometimes done with benefit of the hindsight a patent application provides, and the temptation is hard to resist, but it avoids the real issue of whether the newly claimed invention would have been obvious.

We urge the examiner to consider whether one would have gotten from Dang and Fischell, without using hindsight reasoning, to the invention described in such detail in

claim 1. We suggest that, to reach the invention of claim 1, a person would have to make several changes not taught by the references.

For example, if one started with Dang's solution, a number of mental steps would have to be taken in order to arrive at the present invention:

- A. Select the Dang structure (see Fig. A in the Appendix);
- B. Cut out the bridges (see Fig. B);
- C. Select the Fischell structure:
- D. Take the bridges of the Fischell structure;
- E. Insert those bridges in the modified Dang geometry: but where?
 - a) see Fig. CI with a sequence of two different cells (yellow cell and green cell) that repeat in the circumferential direction
 - b) see Fig. CII with a sequence of three different cells (yellow, green, blue cell) that repeat in the circumferential direction
 - c) see Fig. CIII with a sequence of one cell (blue cell) that repeats in the circumferential direction

As Figs. CI, II and III show, the Dang cell could be modified by these new bridges in an different ways with unpredictable results; moreover, the original long bridges suitable to connect internal bridges were cut, strongly compromising the Dang cell stiffness (see member 50 of figure 3 the bridges connect the central sections 36a-36b of each W-shaped element 30a-30b [see column 5 lines 20-29]).

The modified Dang cell would have lost the desired stiffness Dang described as desirable at col. 5 lines 20-29

The new Dang + Fischell geometry is obviously less stiff in the axial direction and probably not suitable – or not as suitable – for creating the desired scaffolding of the vessel walls covered by the plaque.

In the above reconstruction, we passed over the question of why the person of ordinary skill would have selected Fischell as a reference at all. Fischell does not solve a problem which Dang did not and neither reference suggests the possibility of the modifications the examiner posited.

We respectfully submit that, although various elements of the invention of claim 1 are found in the Dang and Fischell references, one could piece them together so as to arrive at the invention narrowly defined by claim 1 only by using hindsight analysis. It is of course difficult to resist hindsight analysis, but the examiner is asked to reconsider whether a person of ordinary skill in this field would reach the invention of claim 1 merely by following the teachings of the references and using ordinary design skill. We believe so many modifications would have been possible that, except with the guidance provided by the present specification, arriving at the present invention would have been very unlikely and certainly would have involved more than routine experimentation.

An opportunity to interview the examiner, and suggestions for further claim amendment, would be welcome.

Respectfully submitted,

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